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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEVEN M. FRENCH and LORIN E. ULLMANN

Appeal 2008-2769
Application 09/731,624
Technology Center 2400

Decided:[1] March 27, 2009

Before JOHN C. MARTIN, ST. JOHN COURTENAY III, and THU A. DANG, *Administrative Patent Judges*.

DANG, *Administrative Patent Judge*.

DECISION ON APPEAL

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[1] The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

I. STATEMENT OF THE CASE

Appellants appeal from the Examiner's rejection of claims 1-27 under 35 U.S.C. § 134(a) (2002). We have jurisdiction under 35 U.S.C. § 6(b)(2002).

A. INVENTION

According to Appellants, the invention relates to computers that are bootable over a network and, more specifically, to a method for generating a list of operating systems to be made available to a target device that is remotely booted (Spec. 1, ll. 12-15).

B. ILLUSTRATIVE CLAIM

Claim 12 is exemplary and is reproduced below:

12. Computer program product in a computer usable medium for dynamically creating a list of operating systems for a target device in communication with a server, the target device to be remotely booted by the server, comprising:

means for receiving at the target device an available operating systems list of at least one operating system available to the target device;

means for determining a hardware configuration of the target device;

means for determining if the hardware configuration is compatible with each operating system from the available operating systems list; and

means for generating a compatible operating systems list.

C. REJECTIONS

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

DeSimone	US 5,905,872	May 18, 1999
Beelitz	US 6,182,275 B1	Jan. 30, 2001

Claims 12-20 stand rejected under 35 U.S.C. § 102(e) over the teachings of Beelitz; and

Claims 1-11 and 21-27 stand rejected under 35 U.S.C. § 103(a) over the teachings of Beelitz in view of DeSimone.

We REVERSE.

II. ISSUES

Have Appellants shown that the Examiner erred in finding that Beelitz discloses receiving an available operating systems list "at the target device" (claim 12).

III. FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

Beelitz

1. Beelitz relates to a method of generating a compatible order for a build-to-order computer system (col. 1, ll. 32-34).

2. The method includes presenting to a user a list of a first plurality of options that may be implemented on a computer system and generating a list of a second plurality of options that may be implemented on a computer system (col. 2, ll. 27-38).
3. The list of a first plurality of options can be a list of available operating systems (col. 2, ll. 44-46).
4. The list of a second plurality of options can be a list of software programs, wherein each option of the list is compatible with the selected operating system (col. 2, ll. 39-51).
5. More particularly, after receiving an indication via the network connection 110 from terminal 105 that a customer desires to purchase a computer system, control 103 accesses a master data base 125 via a network connection 120 to generate a list of options available for a build-to-order computer system as offered by the manufacturer or computer system vendor, wherein the control computer system 103 then provides the list via the network connection 110 to the terminal 105 where the list is displayed on the terminal screen (col. 4, ll. 40-49; Fig. 1). A second list is generated in response to a user selection from the first list (col. 4, ll. 49-54).
6. The targeted or specified computer system 137 is a computer system on which the selections made by the user as indicated by the user interface 105 are implemented (col. 7, ll. 10-13; Fig. 1).

IV. PRINCIPLES OF LAW

35 U.S.C. § 102

In rejecting claims under 35 U.S.C. § 102, "[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation." *Perricone v. Medicis Pharm.Corp.,* 432 F.3d 1368, 1375 (Fed. Cir. 2005) (citation omitted). "Anticipation of a patent claim requires a finding that the claim at issue 'reads on' a prior art reference." *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1346 (Fed Cir. 1999) "In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art." (*Id.*) (citations omitted).

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987).

V. ANALYSIS

35 U.S.C. § 102(e)

Claims 12-20

Beelitz discloses having the user receive a list of available operating systems from which the user selects the desired operating system, after which the user receives a list of software options that are compatible with

the selected operating system (FF 2-6). We find an artisan would have understood that the claim language "means for receiving . . . an available operating systems list of at least one operating system available to the target device" (claim 12) reads on Beelitz's means for receiving a list of available operating systems.

However, Appellants contend that Beelitz does not disclose means for receiving an available operating systems list "at the target device," but instead discloses that "the 'operating system list' is received at a *user interface 105*" (App. Br. 10). The Examiner responded to this contention by finding that Beelitz discloses "*the master data base 125 to create or generate a list of operating system available for the targeted computer system*" (Ans. 12, quoting Beelitz). Accordingly, we address whether Beelitz discloses receiving an available operating systems list "at the target device" (*id.*).

After reviewing the record on appeal, we agree with Appellants. While Beelitz discloses a list of operating systems that are available *to* the target device (FF 2-6), we find that Beelitz does not disclose that the available operating systems list is received "at the target device" as required by claim 12. That is, although we agree with the Examiner that Beelitz discloses that the list received is "***for*** the targeted computer system" (Ans. 12, emphasis added), the list is not received "at the target device" (claim 12), but is instead presented to the user for the user selection at the user interface

105 to generate an order for a build-to-order (targeted) computer system (FF 1, 2, 5, and 6).

As such, we will reverse the rejection of representative claim 12 and claims 13-20 depending therefrom over Beelitz. We thus conclude that Appellants have shown that the Examiner erred in rejecting claims 12-20 under 35 U.S.C. § 102(e) for the reasons as set forth above.

35 U.S.C. § 103(a)

Claims 1-11 and 21-27

Independent claim 21 recites "means for sending an available operating systems list from a *server* to a target device prior to executing an operating system on a target device" (emphasis added), and independent claim 1 recites "receiving from the *server*, at the target device, an available operating systems list of at least one operating system available to the target device" (emphasis added) (claim 1). The Examiner relies on DeSimone as teaching a server sending a list (Ans. 7).

As discussed *supra* regarding claim 12, although we find that Beelitz discloses an available operating systems list for a targeted device, the list is not received "at the target device" (*id.*), but is instead presented to the user at a user device to generate an order for a build-to-order computer system that is separate from the user device.

We also find that DeSimone does not cure this deficiency of Beelitz. We thus conclude that Appellants have shown that the Examiner erred in

rejecting claims 1-11 and 21-27 under 35 U.S.C. § 103(a) for the reasons as set forth above.

VI. CONCLUSIONS

(1) Appellants have shown that the Examiner erred in finding that claims 12-20 are anticipated by the teachings of Beelitz.

(2) Appellants have shown that the Examiner erred in concluding that claims 1-11 and 21-27 are unpatentable over the teachings of Beelitz and DeSimone.

VII. DECISION

We reverse the Examiner's rejection of claims 12-20 under 35 U.S.C. § 102(e).

Further, we reverse the Examiner's rejection of claims 1-11 and 21-27 under 35 U.S.C. § 103(a).

REVERSED

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